

Appl. No. 11/714,275
Amtd. dated September 13, 2005
Reply to Office Action of June 14, 2005

REMARKS

In the Office Action mailed June 14, 2005, the Examiner raised a restriction requirement, identifying five patentably distinct species of the claimed invention, as follows:

1. Group 1, drawn to FIGS. 1A -1B and 2;
2. Group 2, drawn to FIGS. 3A - 3B;
3. Group 3, drawn to FIGS. 4A - 4C;
4. Group 4, drawn to FIGS. 5 - 6; and
5. Group 5, drawn to FIGS. 7.

In addition, in the Office Action, claims 1 - 5 and 7 were rejected under 35 U.S.C. § 103(a), as allegedly obvious, over U.S. Patent No. 5,016,468 to Cassata ("the Cassata patent"). Claims 1 - 5 and 7 were also rejected, as allegedly obvious, over U.S. Patent No. 3,009,381 to Rapata ("the Rapata patent"). Claims 8, 9, and 10 were rejected, as allegedly obvious, over the Rapata patent in further view of over U.S. Patent No. 1,690,129 to Prentiss ("the Prentiss patent"). Claims 10 and 11 were rejected, as allegedly obvious, over the Rapata patent in further view of over U.S. Patent No. 5,785,181 to Quartararo ("the Quartararo patent"). Claims 1 - 9 were rejected, as allegedly obvious, over U.S. Patent No. 2,897,561 to Megibow ("the Megibow patent") in view of the Cassata patent.

Applicant hereby confirms the election of Group 1. Claims 13 - 33 have been canceled. Claims 34 - 38 have been added. Claims 1 - 12 and 34 - 38 are readable upon the elected species. Claim 1 is generic to Groups 1 - 4.

Applicant notes that no rejection has been made against claim 12; however, it has not been indicated as covering allowable subject matter. Clarification is requested.

Below, Applicant briefly discusses the present invention, addresses the rejections to the pending claims, and discusses the new claims.

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I. The Present Invention

Generally speaking, the invention provides a garment label that can be affixed to a garment in a permanent, yet, removable manner. The garment label includes indicia providing country of origin, garment provider, and fiber content. Indicia for care instructions and garment size can also be included. This allows garment providers to comply with relevant requirements, while allowing consumers to remove the label from the garment without risk of damage to the garment. Moreover, it solves concerns of privacy, theft deterrence, tag protrusion, unattractiveness and irritation in a manner neither contemplated nor addressed by the prior art.

II. Rejection of Claims based upon the Cassata Patent

As mentioned above, claims 1 – 5 and 7 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Cassata patent. Applicant respectfully traverses these rejections for the following reasons.

A. Claim 1

Among other things, independent claim 1 defines a garment label having a planar member, an attachment mechanism, and "indicia including country of origin, garment provider identifier, and fiber content." Also, for clarification, claim 1 is amended to recite the garment tag as a removable garment tag.

In paragraph 11, the Examiner correctly asserts that the Cassata patent "does not teach the indicia including country of origin, garment provider comment and fiber content." However, the Examiner continues, stating the following:

"[T]he specific indicia [of the claims] has *not* been given patentable weight. It would have been obvious to one having ordinary skill in the art at the time of this invention was made to construct the device taught by Cassata with any suitable indicia to convey a desired message"

In response, Applicant respectfully asserts that, by failing to consider all claim limitations, the Examiner has failed to establish a *prima facie* case of obviousness. In a establishing a *prima facie* case of obviousness, the Examiner must consider the invention *as a*

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whole, to include all claim limitations. Particular limitations of a claim cannot simply be disregarded. *See MPEP 2143*. Doing so is improper.

It is respectfully submitted that the present rejection stands the burden of proof on its head, requiring the Applicant to prove an "unobvious functional relationship." However, the burden is on the Examiner to prove obviousness of the recited structure. Merely providing a conclusory statement and asserting that the recited elements do not have an unobvious functional relationship, without prior art support for such a conclusion, fails to meet the burden established on the USPTO, and thus on the Examiner of the application. Reconsideration is respectfully requested.

A prima facie case of obviousness must establish a suggestion or motivation in the prior art, to arrive at the claimed invention, based on actual evidence. Broad conclusory statements, such as the one above, are insufficient. See In re Dembiczaik, 175 F.3d 994, 1000 (Fed. Cir. 1999).

In re Dembiczaik is instructive as to the requirements for establishing obviousness, particularly regarding the "motivation to combine." It is particularly analogous to the present application in that Dembiczaik's invention also includes claim limitations for "indicia."

In that case, the invention was directed towards an orange plastic bag having "facial indicia" to simulate a general appearance of a jack-o'-lantern. The examiner rejected all claims, as allegedly obvious, in light of a conventional trash bag and selected arts-and-crafts books that allegedly taught the missing facial indicia. For example, one reference, "the Shapiro reference," described a method of making a paper bag pumpkin by stuffing a paper bag with newspapers and adding facial features to the bag. In combining Shapiro and the conventional trash bag, the examiner (and the Board of Patent Appeals) stated that the Shapiro reference would have suggested the application of facial indicia to prior-art plastic trash bags.

The Federal Circuit reversed the obviousness rejection. It held that the rejection failed to establish any evidence that there was a suggestion, teaching, or motivation to combine the references. To have been proper, the examiner would have needed to establish specific

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findings of fact regarding a specific source, in the prior art, motivating one of skill in the art to arrive at orange plastic bag having facial indicia. 175 F.3d at 1000. Thus, not only must the examiner consider the "facial indicia," the examiner must also establish specific findings, from the prior art, that one would have been motivated to arrive at the claimed invention.

In this instance, the Examiner not only failed to provide a motivation to combine Cassata's device with the specific indicia, the Examiner failed even to consider the specific indicia. It is not enough to assert, "it would have been obvious... to construct the device taught by Cassata with any suitable indicia to convey a desired message." None of the claims of the present application is directed to a label that includes "any suitable indicia." Rather, claim 1, and its dependent claims, requires specific indicia, to include "country of origin, garment provider and fiber content."

The Examiner has failed to consider these requirements of the claims and failed to set forth any motivation as to why one skilled in the art would have provided Cassata's device with the specific indicia of claim 1. As demonstrated by In re Dembicza, this is improper. Limitations relating to indicia must be considered as specifically set forth in the claim.

Moreover, even if considered, the Cassata patent fails to provide any motivation to provide a removable garment label, as set forth in claim 1. Instead, the device of the Cassata patent is configured to be permanently attached and makes no mention of the specific indicia of claim 1. The Cassata patent discloses a locking engagement of a downwardly projecting locking surface 48 formed of a lip 44 engaging an upper posterior shoulder 64 of an enlarged portion 62 of head 58 of a locking pin 54 that "non-releasably secures the parts together." (Abstract, col. 3, lines 14-17). Indeed, as one of its features the Cassata teaches that "[t]here is thus virtually no camming effect produced by the shoulder 64 such as would pry or flex the sections 46a, 30a, outwardly such as would enable the parts to be separated." (col. 3, lines 42-5).

Accordingly, the rejection of claim 1, as allegedly obvious over the Cassata patent, is improper and should be withdrawn.

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B. Dependent Claims 2 – 5, and 7

Dependent claims 2 – 5 and 7 depend from claim 1, adding features that further define the invention and further distinguish over prior art.

For example, claim 2 requires indicia for care instructions, and claim 3 further requires indicia for garment size. The Cassata patent fails to disclose such features.

For these reasons, and for the reasons set forth above, the rejection of claims 2 – 5, and 7, as allegedly obvious over Cassata, is improper and should be withdrawn.

III. Rejection of Claims based upon the Rapata Patent

As mentioned above, claims 1 – 5 and 7 were rejected, as allegedly obvious over the Rapata patent. Claims 8, 9, and 10 were rejected in further view of the Prentiss patent. Claims 10 and 11 were rejected in further view of the Quartararo patent. Applicant respectfully traverses these rejections for the following reasons.

A. Claims 1 – 5 and 7

The Rapata patent requires an apertured workpiece, which is to be sealed, and thus neither contemplates, discloses nor suggests any possibility of a releasable, removable or reattachable arrangement of its parts. The studs 30 and fastening members 32 each having an aperture 42 with a diameter less than that of shoulder 40 of the stud (col. 2, lines 33-38), such that the fastening member compresses the workpiece and is retained by the shoulder (col. 2, lines 56-62). Thus, the fastening members 32 seal the apertures (col. 3, line 3) and, similarly to Cassata, are locked in place.

In paragraph 16, the Examiner correctly asserts that the Rapata patent “does not teach the indicia including country of origin, garment provider comment and fiber content.” However, the Examiner continues, stating the following:

“[T]he specific indicia [of the claims] has *not* been given patentable weight. It would have been obvious to one having ordinary skill in the art at the time of this invention was made to

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construct the device taught by Rapata with any suitable indicia to convey a desired message"

Applicant respectfully asserts that the rejection based on the Rapata patent fails to establish a *prima facie* case of obviousness. As discussed above, the Examiner must consider the invention as a whole, to include all claim limitations. Particular limitations of a claim cannot simply be disregarded.

The rejection of claims 1 – 11, based on the Rapata patent, all suffer this shortcoming. Accordingly, the rejection is improper and should be withdrawn

B. Claim 8, 9 and 10

The rejection set forth in paragraph 19 is defective and not understood, as the rejection purports to reject claim 8 (along with claims 9 and 10) over "Rapata as applied to claim 8" further in view of Prentiss. On its face, such a rejection appears to be a bootstrap argument without consideration of the provided elements. Clarification is in order and courteously requested.

For example, claim 9 further requires that the plurality of holes are curved and terminate within the backing member such that a corresponding piercing element of the plurality of piercing elements is bent once received within the holes.

In addition to the deficiencies noted above, the Rapata patent fails to teach any curved holes or bent piercing elements. Moreover, the Prentiss patent similarly fails to teach any such structure. It is noted that, similarly to the bayonet structure shown at Fig. 9 of the Rapata patent, the Prentiss patent discloses a separable button having straight shanks 3 and 4, with saw tooth like shoulders 14 and 15 (Figs. 3, 4 and 5). The four piece structure includes an insignia head 2 having the shanks, a disk shaped background member 6 having apertures 7 and 8, a base member 16 and movable capped-tongue structures 24-25 for receiving and engaging the straight shanks.

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Therefore, even if combined with Rapata, the resultant combination neither teaches, discloses nor suggests the structure recited in claim 9, including a plurality of curved holes defined in and terminating within the backing member, so that piercing elements received in the holes are bent thereby.

Accordingly, the rejection of claims 8 – 10 is improper and should be withdrawn.

IV. Rejection of Claims based upon the Megibow Patent in view of the Cassata Patent.

In paragraphs 21-28, claims 1 – 9 were rejected, as allegedly obvious, over the Megibow patent in view of the Cassata patent.

Among other things, independent claim 1 set forth a garment label having a planar member, an attachment mechanism, and indicia including country of origin, garment provider identifier, and fiber content.

In paragraph 24, the Examiner correctly asserts that "Megibow or Cassata does not teach the indicia including country of origin, garment provider comment and fiber content." However, the Examiner continues, stating the following:

"[T]he specific indicia [of the claims] has *not* been given patentable weight. It would have been obvious to one having ordinary skill in the art at the time of this invention was made to construct the device taught by Megibow with indicia as taught by Cassata with any suitable indicia to convey a desired message."

Applicant respectfully asserts that the rejection based on the Megibow patent and the Cassata patent fails to establish a *prima facie* case of obviousness. As discussed above, the Examiner must consider the invention *as a whole*, to include all claim limitations. Particular limitations of a claim cannot simply be disregarded.

The Megibow patent fails to disclose any teaching or suggestion that the structure shown is "a garment or clothing identifier/button or tag," as asserted. Any such suggestion is only drawn upon consideration of Applicant's own disclosure – i.e., by application of impermissible hindsight to the prior art. Instead, the Megibow patent provides a "fastener" and

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refers to permanently fastened prior art buttons, as well as to fabrics and cloths. (col. 1, lines 29-40).

The manner of semi-permanent attachment provided by the clip fastener of Megibow requires cooperation between the legs extending from head 1 and two devices, specifically spreading mechanism (6) and guide means (18). (col. 2, lines 54-61). The Megibow patent utilizes two backing members 6 and 18 (or 29 and 27), one of which the member (6) has through-holes (7, 8) cooperating with a spreader member (13) that merely spreads legs (2, 3). (col. 2, lines 43-47). The legs are not bent by through-holes 7,8 but, in fact, are bent by the separate backing plate 18, as a "guide means positioned rearwardly of the wedge 13." (col. 2, lines 36-39). It is this guide means (18) which "comprises a curved surface" that bends and directs the legs through outer apertures 9, 10. (col. 2, lines 50-53).

The Cassata patent fails to teach, disclose or suggest any obvious manner by which the Megibow structure could be reconfigured to obtain Applicant's recited structure. It is therefore respectfully submitted that the art applied in paragraphs 21-22 fails to anticipate or obviate the features of Applicant's invention.

Moreover, analysis of the two references reveals significant distinctions. Indeed, it is clear that the teaching of the Megibow patent contradicts that of Cassata and is not compatible therewith and, accordingly, that the very combination of references would be unavailable as being based on hindsight gathered from Applicant's own disclosure. More specifically, as noted elsewhere herein, Cassata discloses a structure intended to provide a locking engagement and to secure its two parts permanently and "non-releasably." On the other hand, the Megibow patent provides a disengageable fastener which only semi-permanently engages its pieces, thus contradicting the objectives of Cassata. Moreover, while the Cassata structure requires only a simple two-piece structure, the Megibow patent teaches a three-piece configuration.

As such, without the hindsight benefit of Applicant's own disclosure, there would be no basis for combining Megibow's three piece semi-permanent structure, including a backing

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having a curved surface, with the two piece permanent structure of Cassata to obtain the two piece structure having curved holes, as set forth in Applicant's claims 6 and 9. As the art of record does not appear to suggest a manner in which such a combination could be implemented, it can only be concluded that the combination is based on impermissible hindsight and is thus unavailable as a prior art showing of obviousness of Applicant's invention. Therefore, the combination of Megibow and Cassata is not available as prior art against the present invention.

Accordingly, the rejection is improper and should be withdrawn.

A. Claims 6 and 9

The rejection of claims 6 and 9 fails to identify a prior art reference for support. It is noted that claim 6 stands rejected only at paragraph 26 of the Action. Towards that end, claim 6 is presented in independent form. The Examiner is courteously reminded that, in the event any specific art is applied to claim 6 in a future rejection, such a rejection will constitute a new grounds of rejection, which is not based on applicant's amendment and, as such, cannot be made final.

In any case, inasmuch as the rejection of Applicant's attorney has reviewed the art of record actually applied by the Examiner and provides the following observation.

The Cassata patent fails to provide or suggest a structure in which each of a plurality of holes is curved and in which a corresponding piercing element is bent once received within such a hole. It is noted that, although the Megibow patent has not been applied to these claims, what appear to be piercing elements (2, 3) therein appear to be curved at Fig. 2. However, the structure which causes the illustrated curvature and bending of the piercing elements is clearly a "curved surface of a grooved backing 18" (col. 2/38) rather than any "hole [which] is curved and terminates within the backing," as required by claims 6 and 9.

Thus, the Megibow patent and the Cassata patent singly, and in combination, fail to disclose, or suggest, a garment label as set forth in claims 6 or 9.

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V. New Claims

A. New Claims 34 – 36

In addition to the limitations present in claim 1 which in and of themselves are patentable over and differentiated from the art applied thereto, and which are incorporated in each dependent claim, new dependent claims 34 – 36 provide further clarification of still additional features of the invention which are themselves patentable over the applied art.

For example, claim 34 recites the planar member as including a planar display means for displaying the indicia identifying characteristics of the garment. As elsewhere noted herein, Applicant traverses the Examiner's failure to consider patentability of the language of claim 1 relating to the indicia. However, claim 34 clearly provides a structural relationship between the indicia and the elements of the invention, requiring planar display means for performing a particular function.

In accordance with the provisions of 35 U.S.C. § 112, paragraph 6, the function performed by the recited means must be considered with respect to patentability of the invention as a whole. Therefore, irrespective of the Examiner's position with respect to the recitation of indicia at claim 1, display of specific indicia (recited as including country of origin, garment provider identifier, and fiber content) can no longer be ignored in consideration of the recitation of claim 34.

Moreover, in new claim 35 the hole of claim 1 is recited as being defined by curved sidewalls in the backing member which cause bending of the piercing element, thereby providing removable engagement of the planar member to the backing member. Similarly, new claim 36 requires the piercing element to be deformable in accordance with a configuration of the sidewalls in the backing member to provide the removable attachment between the planar member and the backing member.

As is apparent upon consideration of the Megibow patent, the prior art fails to provide sidewalls of a backing member that bend the piercing element. Instead, there is provided a guide member, separate from any member having holes therein, having an upper surface which

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appears to cause bending of legs (2, 3). Therefore, it is courteously submitted that the Megibow patent, with or without the Cassata patent, fails to teach, disclose or suggest the invention as recited in new claims 34 - 36.

B. New Claims 37 - 38

Still further, new claims 37 - 38 provide a structure which is even more clearly differentiated from the art of record. More particularly and for example, claim 37 requires the sidewalls of the holes within the backing member to deform the axial direction of the piercing means to attach the planar member to the backing member in a fixed configuration which engages the garment therebetween. It is quite clear that, even if Megibow and Cassata were applied to claim 37 nothing therein would suggest such an arrangement for what the Examiner has alleged as being the backing member, element 6 of Megibow.

Additionally, claim 37 requires a pry point for prying apart the planar and backing members. No such pry point is suggested by the above noted references.

For example, the semi-permanent fastener of Megibow is detachable by "a pull sufficiently great to re-bend the said legs." (col. 2, lines 4-5). However, as disclosed at paragraph 30 of the present specification, a pry point is provided to exert force sufficient to separate the planar and back members.

Moreover, new claim 37 explicitly requires, and the art fails to show, a means for performing a particular function - specifically the function of "displaying indicia for identifying characteristics of the garment including country of origin, garment provider identifier, and fiber content."

Accordingly, as hereinabove noted with respect to new claim 34, irrespective of the propriety or impropriety of ignoring patentability of the recitation in claim 1, it is courteously submitted that 35 U.S.C. § 112, paragraph 6, requires consideration of the function recited in claim 37, and that no such function of displaying indicia for identifying characteristics of the

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garment including country of origin, garment provider identifier and fiber content is disclosed or suggested by the art of record.

In addition, new claim 38 provides a particular feature, which clearly is not shown by what the Examiner alleges to be the "backing member 6" of Megibow.

New claim 38 explicitly and specifically requires a configuration in which the sidewalls of the holes in the backing member bend the piercing means by approximately 90 degrees in the axial direction thereof to engage the garment between the planar member and the backing member. This arrangement is clearly shown in Applicant's Figs. 1A, 1B, 3A and 3B, for example. No such configuration, wherein sidewalls of holes in a backing member bend approximately 90 degrees, is shown or suggested by the applied art, and no art of record would suggest such a configuration to one of ordinary skill in the art.

Accordingly, it is courteously submitted that the art of record neither anticipates, nor would have made obvious to one of ordinary skill in the art, the configuration recited in newly submitted claims 34 – 38.

VI. Conclusion

The foregoing remarks should place this application in condition for allowance. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, he is respectfully requested to call the undersigned attorney at the number indicated below.

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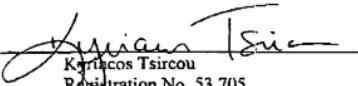
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Date: September 13, 2005

Respectfully Submitted,

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